

REMARKS

This Amendment is responsive to the Office Action mailed June 16, 2005. The Examiner's comments have been carefully considered.

The specification and claims 4 and 5 have been objected to for reasons set forth in paragraph 1 on page 2 of the Office Action. These have been amended to address these objections, and it is respectfully requested that the Examiner withdraw the objections to the specification and claims 4 and 5.

The examiner has also requested new corrected drawings in paragraph 2 of the Office Action. During a telephone conference with the Examiner on December 15, 2005, the undersigned attorney for applicant discussed this new drawings requirement. The examiner indicated that corrected drawings, in fact, had been received by the U.S. Patent and Trademark Office, and that, therefore, this requirement is no longer applicable.

Claims 1 and 15 have been rejected under 35 USC § 112 because these claims do not comply with 37 CFR § 1.75(e) and do not contain an appropriate preamble. Both claims 1 and 15 have been amended and it is respectfully submitted that, as amended, these claims satisfy the aforementioned rule.

Claim 1 has also been rejected as being indefinite because the Examiner has asserted that the "identifier" in claim 1 was described as being "coupled" but did not set forth what the identifier was coupled to. Claim 1 has been additionally amended to address this rejection. In view of the amendments to claims 1 and 15, it is respectfully submitted that the rejections have been overcome and should be withdrawn.

In paragraph 4 of the Office Action, claims 1-3 and 5-20 have been rejected as being obvious and therefore unpatentable in view of U.S. Patent No. 6,061,650 issued to Malkin, in view of or when combined with U.S. Published Patent Application No. 2001/0009025. Claims 1-3 and 5-20 have also been rejected as being obvious and therefore unpatentable on the basis of Malkin in view of or when combined with Ahonen, as previously stated, in further view of or when further combined with U.S. Published Patent Application No. 2003/0032414 to Melaku for reasons set forth on page 6 of the Office Action.

Although claims 4 and 5 were indicated as "objected to" on the "Office Action Summary," the Examiner has, during a telephone conference with the undersigned

attorney for applicant, confirmed that claims 4 and 5 have likewise been rejected on prior art for the reasons set forth on page 6 of the Office Action.

For reasons more fully discussed below, and in view of the Amendments that have been made to the claims, the prior art rejections are respectfully traversed and the examiner is kindly requested to reconsider and withdraw these rejections. In this connection, it is respectfully pointed out that independent claims 1 and 15 have been amended to incorporate the subject matter of claims 6 and 18, respectively, so that both independent claims of record now require a proxy of the type shown in Fig. 1, at reference number 36, and described in the specification, for example, at page 11, line 17, to page 12, line 23.

It appears that the Examiner has cited Ahonen merely because it discloses a mobile station in connection with authentication procedures. However, apart from that one teaching, Ahonen does in our opinion not appear to be relevant or related to the teaching of Malkin.

Malkin does not authenticate the mobile node at all. According the Abstract and column 2, lines 37-38, of Malkin, the Service Provider Network will perform authentication on behalf of the remote node. Thus, Malkin does not read on the present claims, which define an “apparatus for facilitating authentication of the mobile station”.

This apparatus is a proxy, now required by both independent claims. It seems that Malkin does not disclose a proxy element in Fig. 1, despite the Examiner’s suggestion to the contrary. All elements in Fig. 1 represent different functionalities than a proxy.

In order to make this difference clearer in the claims, the feature of sub-claim 6 has been incorporated into claim 1 and the feature of subclaim 18 has been likewise incorporated into claim 15.

The amended independent claims, it is respectfully submitted, clearly distinguish over the cited prior art since the proxy adds information for facilitating an authentication initiated by the mobile station.

Further, an authentication of a mobile station according to the present invention as currently claimed is effected through interaction of the mobile station with a selected authenticator. Namely, as can for example be gathered from page 3, lines 20 to 23, and from page 15, lines 1 to 2 of the specification in connection with Figure 3, an

authentication request is generated at the mobile station and then transmitted to the access network selected for communication.

In contrast thereto, Malkin teaches that the remote node dials into the access network, i.e. to the RAS 12, then the RAS 12 queries information from the database system TMS 16, and then the RAS 12 (and not the remote node) generates an authentication request (cf. col. 2, lines 26 to 45 of Malkin). Consequently, the alleged identifier according to Malkin (i.e. the RAS 12) does not receive an authentication request or an indication thereof, but generates such an authentication request on its own.

Consequently, the presently claimed subject-matter of present independent claims 1 (with the feature of claim 6) and 15 (with the feature of claim 18) essentially differs from what is taught by Malkin. Thus, even in view of Ahonen, it would not have been obvious for a skilled person at the time the invention was made to arrive at the solution of the present invention.

It is also respectfully submitted that it would not be obvious to combine the references as proposed by the examiner because Ahonen is not concerned with the analogous subject matter. Ahonen has indicated, at column 1, lines 7-9, that his disclosure relates to computer networking systems and is concerned with allowing computers to be linked to a network. Therefore, even if the references were to be combined as proposed by the examiner, the proposed combination would still not result in the subject matter as now recited in amended claims 1 and 15. Still, additional, inventive modifications would need to be made to arrive at the claimed subject matter. However, it is respectfully submitted that such additional inventive modifications could only be achieved by inventive input or the benefit of hindsight of the present application and the subject matter disclosed therein. However, in any attempt to establish obviousness, the use of such reconstructive hindsight is clearly prohibited.

The statutory standard for the ultimate determination of obviousness provides that a claimed invention is unpatentable if the differences between it and the prior art 'are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.' 35 U.S.C. § 103 (1994). In line with this statutory standard, the case law provides that 'the consistent criterion for determination of obviousness is whether the prior art would have suggested to one of

ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art.’ *In re Dow Chem.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988).

Two requirements are contained in this criterion. The first requirement is that a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential evidentiary component of an obviousness holding.’ *C.R. Bard, Inc., v. M3 Sys. Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)."

(i) This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. *See Pro-Mold & Mold Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. *See Om re Roufflet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

(ii) The showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not ‘evidence.’ *See Dembiczak*, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617.

The U.S. Patent and Trademark Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (‘a showing of suggestion, teaching, or motivation to combine the prior art references is an "essential component of an obviousness holding"’ (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998))); *In re Dembiczak*, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (‘Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.’); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)

(there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined *only* if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ('particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed'); *In re Roufflet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ('even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.');

In re Fritch, 972, F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references').

Thus, where the Board has rejected the need for 'any specific hint or suggestion in a particular reference' to support the combination of the ... references, omission of a relevant factor required by precedent is both legal error and arbitrary agency action. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002)

Thus, it is clear that to establish a *prima facie* case of obviousness, the U.S. Patent Office must, *inter alia*, show 'some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). *See, also, In re Thrift*, 298 F.3d 1357, 63 USPQ2d 2002 (Fed. Cir. 2002).

There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). Anything less is clearly hindsight reconstruction, which has been consistently forbidden by the courts.

Here, the Examiner has simply alleged some broad conclusory statements, without pointing to any objective evidence in the references or elsewhere, that shows it would have been obvious to combine because the motivation to do so was present in the prior art. This is error, and it fails to establish a prima facie showing of obviousness under 35 U.S.C. § 103.

In view of the foregoing, it is respectfully submitted that the prior art, on the record, does not establish a motivation for the proposed combination. Furthermore, as suggested above, even if the motivation was there to combine the references as proposed by the Examiner, the resulting combinations would still fail to meet the limitations of the rejected claims, particularly as amended herein. Accordingly, the Examiner is respectfully requested to reconsider the rejections of the claims and withdraw the same.

The application is now believed to be in condition for allowance. Early allowance and issuance is, accordingly, respectfully solicited.

Applicant hereby petitions that any and all extensions of time of the term necessary to render this response timely be granted. COSTS FOR SUCH EXTENSION(S) AND/OR ANY OTHER FEE DUE WITH THIS FEE DUE WITH THIS PAPER THAT ARE NOT FULLY COVERED BY AN ENCLOSED CHECK MAY BE CHARGED TO DEPOSIT ACCOUNT #10-0100.

Date: December 16, 2005

Lackebach Siegel LLP
One Chase Road
Scarsdale, NY 10583
Telephone: 914 723 4300

MG/ae-as

Respectfully submitted,

LACKENBACH SIEGEL LLP
Attorneys for Applicant(s)
Customer No. 28752

By: 

MYRON GREENSPAN
Reg. No.: 25,680